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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,989	12/04/2000	Jean-Francois Le Pennec	FR919990114US1 (13739)	6561
7590	02/13/2004		EXAMINER	
Richard L. Catania Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			MASHAAL, ALI M	
			ART UNIT	PAPER NUMBER
			2136	
DATE MAILED: 02/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/728,989	LE PENNEC ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ali M. Mashaal	2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 December 2000.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 December 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

### **DETAILED ACTION**

- 1) This action is in response to the application filed 05/14/2001.
- 2) Claims 1-18 are under examination.

#### ***Specification***

- 3) The disclosure is objected to because of the following informalities: Page 9, line 3, "the difficulty to fine them," should apparently read "the difficulty to find them."

Appropriate correction is required.

#### ***Claim Objections***

- 4) Claims 5 and 14 are objected to because of the following informalities:

As per claim 5, line 3 recites "the list..." with a lack of antecedent basis in the base claim. Examiner suggests substituting "the list" with "a list". Appropriate correction is required.

As per claim 14, line 7 recites "certificate Comprises." Which is apparently grammatically incorrect. Examiner suggests substituting this text with "certificate."

#### ***Claim Rejections - 35 USC § 103***

- 5) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5.1) Claims 1, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,301,658 to Koehler in view of US Patent No. 6,021,510 to Nachenberg.

Koehler discloses a method, for use in a certificate cache, of caching one or multiple certificates, each certificate certifying that a file is authentic, said method comprising the steps of: receiving a certificate request for a file ( see col. 8, lines 53-58); identifying the file in a cache table comprising for each identified file one or a plurality of certificates (see col. 6, lines 41-45); selecting in the cache table one certificate for the identified file, (see col. 6, lines 41-45); retrieving from the cache table said selected certificate (see col. 6, lines 41-45); sending back in response to the certificate request the retrieved certificate (see col. 5, lines 42-62, specifically lines 53-55).

Koehler fails to explicitly disclose the certificates pertain to viruses; certifying that a file is virus-free. Furthermore, Koehler fails in his disclosure of the step of selecting in the cache table one virus-free certificate for the identified file, to include the limitation of "using one or a plurality of anti-virus criteria."

However, Nachenberg in an analogous art, clearly discloses the certificates pertain to viruses; certifying that a file is virus-free (see col. 1, lines 12-22). Furthermore, Nachenberg discloses in the step of selecting in the cache table one virus-free certificate for the identified file, the limitation of "using one or a plurality of anti-virus criteria" (see col. 3, lines 6-20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the features of certifying files are virus free by use of a virus detection program such as NAV with all its detection criterion

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as taught by the Koehler invention, and caching the certificates in a table. One would have been motivated to do so with a reasonably expected successful outcome of efficient and accelerated virus scanning, as taught by Nachenberg (see col. 1, lines 18-22).

As per claim 2, the Koehler-Nachenberg combination discloses the limitations of the base claim. Nachenberg further discloses wherein the virus-free certificate request comprises a list of one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free or not, (Antivirus scan module 3 in the figure, and see col. 3, lines 5-20). It would have been to one having ordinary skill in the art at the time the invention was made to scan the file using one or a plurality of anti-virus programs to execute on the file to determine whether the file is virus-free or not, as taught by Nachenberg, in the Koehler-Nachenberg combination. One would have been motivated to do so because the Koehler-Nachenberg combination is silent as to the method used to certify the file virus-free, and Nachenberg teaches only this method.

As per claim 3, the Koehler-Nachenberg combination discloses the limitations of the base claim, and furthermore inherently discloses the limitation of the instant claim because in order to achieve the step of "receiving a virus-free certificate request for a file" as cited in the base claim, the file for which the request is being made necessarily/inherently has an identification by which it is requested.

As per claim 4, the Koehler-Nachenberg combination discloses the limitations of the base claim. Koehler also discloses the virus-free certificate request comprising an identification of a virus-free certificate authority, said virus-free certificate authority having authority to generate virus-free certificates (see col. 5, lines 44-50 & col. 6, lines 41-42).

As per claim 6, the Koehler-Nachenberg combination discloses the limitations of the base claim. Koehler also discloses the virus-free certificate comprising a virus-free certificate authority identification (see col. 2, lines 34-39).

As per claim 10, the Koehler-Nachenberg combination discloses the limitations of the base claim. Also, Koehler further discloses updating the cache and storing an entry in the cache (see col. 8, lines 53-58).

As per claim 11, it is rejected on the same basis as claim 10, because it has been held that it is an obvious design choice to duplicate parts for multiple effects, in re St. Regis Paper Co. v Bemis Co. 193 USPQ 8 (7<sup>th</sup> Cir. 1977), and claim 11 compared to claim 10 adds a third cache.

As per claims 12-14, the Koehler-Nachenberg combination discloses the limitations of the base claim. Also, Koehler further discloses selecting in the cache table one or a plurality of virus-free certificates, using an information indicating for each virus-

free certificate the date of the latest virus-free certificate request which has been received for said virus-free certificate, and discarding from the cache table the virus-free certificate which are no more valid (see abstract).

As per claims 15 and 16, the Koehler-Nachenberg combination discloses the limitations of the base claim. Also, Koehler further discloses the certificate comprising a file signature..., a file identification..., a public key for decrypting the file signature, a certificate signature..., and an indication of the virus-free certificate validity, (see col. 2, lines 34-50).

5.2) Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,301,658 to Koehler in view of US Patent No. 6,021,510 to Nachenberg, and further in view of US Patent No. 5,311,591 to Fischer.

As per claim 5, the Koehler-Nachenberg combination discloses the limitations of the base claim, but fails to disclose wherein the virus-free certificate comprises the list of the one or plurality of anti-virus programs that have executed on the file. However, Fischer in an analogous art, adequately discloses this limitation (see col. 6, lines 33-46 in which Fischer teaches that information pertaining to the level of trust that is granted is included in the construction of the certificate). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine this teaching of Fischer with the Koehler-Nachenberg combination such that the certificates in the Koehler-Nachenberg combination included the anti-virus programs that were run

on the file in order to certify the file clean. One would have been motivated to do so because this would give the requester a sense of exactly how trustworthy the certificate is, and the criteria by which it was certified.

5.3) Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,301,658 to Koehler in view of US Patent No. 6,021,510 to Nachenberg as applied to the base claim, and further in view of US Patent No. 6,058,484 to Chapman et al. (Chapman).

As per claims 7 and 8, the Koehler-Nachenberg combination discloses the limitations of the base claim, but fails to disclose comparing the criteria (list of virus programs/ CA) requested to those in the certificate and selecting a certificate having at least the list being requested. However, Chapman in an analogous art discloses selecting, among many certificates, one that meets a specified criteria that is compared to data on the certificate (col. 10, lines 45-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Koehler-Nachenberg combination so that the step of selecting included comparing the criteria (list of virus programs/ CA) requested to those in the certificate and selecting a certificate having at least the list being requested. One would have been motivated to do so because this would further allow the requester to determine how valid and trustworthy the certificate is.

5.4) Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,301,658 to Koehler in view of US Patent No. 6,021,510 to Nachenberg as applied to the base claims, and further in view of US Patent No. 5,257,361 to Doi et al. (Doi).

As per claim 9, the Koehler-Nachenberg combination discloses the limitations of the base claim, but fails to disclose forwarding the request to a second cache when the certificate is not found in a first cache and if found in the second cache sending back in response to the request the certificate. However, Doi in an analogous art, discloses searching a second cache when a searched element is not found in a first cache (see col. 13, lines 13-26). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Koehler-Nachenberg combination so that the step of identifying the file in a cache further included searching a second cache when a searched element is not found in a first cache as taught by Doi. One would have been motivated to do so because this would increase the chances of finding the certificate desired.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following is a list of pertinent art:

6,088,803

6,021,510

5,473,769

5,999,723

6,094,731

6,347,398

5,633,933

6,092,202

6,321,333

6,301,658

5,311,591

6,611,925

6,058,484

5,257,361

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali M. Mashaal whose telephone number is 703-305-7854. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AM

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